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PATENT

Attorney Docket No. A-70882/AMP/CYO

Attorney Client Matter No. 467802-00341

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ROSSI

Serial No. 10/053,355

Filed: November 8, 2001

For: *Production of Cultured Human Mast
Cells and Basophils for High
Throughput Small Molecule Drug
Discovery*

Examiner: LI, Q. J.

Art Group No. 1632

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Non-Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Date: October 14, 2003

Signature *Jere Valles*
Jere Valles

RESPONSE TO OFFICE COMMUNICATION

Mail Stop Non-Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant is in receipt of the Office Communication, mailed 11 September 2003, which holds that Applicant's reply of 13 June 2003 is non-responsive to the Notice of Restriction Requirement. The Examiner contends that the amendments allegedly shifted the claimed invention from the elected inventive group. Applicant disagrees.

Applicant does not understand the position of the USPTO with respect to the pending claims. In the Restriction Requirement, the Examiner restricted the claims into four inventive groups. The subject matter of Group II (original Claims 1, 2, 5-7, 10-12, 15, 18, and 21-34) included claims directed to a method of differentiating cells to form a proliferated population of mucosal mast cells, cells produced by the method, and methods of using the mucosal mast cells. The subject matter of Group III (original Claims 1, 3, 5, 6, 8, 10, 11, 13, 16, 19, 21-23, and 35)

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included claims directed to a method of differentiating cells to form a proliferated population of connective tissue-type mast cells, cells produced by the method, and a method of using the cells for screening. In response to the Notice of Restriction Requirement, Applicant elected Group II (original Claims 1, 2, 5-7, 10-12, 15, 18, and 21-34) with traverse, requesting that the claims of Group III be joined in examination because both groups of claims were classified in the same class and subclass and concurrent examination of the two groups would not impose an undue burden on the Examiner.

At the same time, Applicant cancelled the original claims in favor of new claims. These new claims are directed to a method of differentiating cells to form a proliferated population of mast cells, cells produced by the method, and methods of using the mast cells. As such, the pending claims are entirely consistent with Groups II and III. For instance, the subject matter of pending Claim 38 is drawn to the same subject matter as original dependent claim 2 (directed to a method of forming a proliferated population of mucosal mast cells), while pending Claim 39 is drawn to the same subject matter as original dependent claim 3 (directed to a method of forming a proliferated population of connective tissue-type mast cells). Additionally, the mast cells produced by the method are recited in pending Claims 53-66, which reiterate the subject matter of original Claims 34-35. The method of identifying agents producing an altered phenotype are recited in pending Claim 67, which reiterates the subject matter of original Claims 15 and 16. Thus, the pending claims are entirely consistent with the original claims of Groups II and III and do not represent a shift from the scope of those groups.

In addition to traversing the rejection, Applicant pointed out that, like original Claim 1, which was included in both Groups II and III, new generic Claim 37 links the subject matter of Groups II and III. Since the generic claim is consonant with the elected group in light of Applicant's traversal of the restriction requirement, Applicant reiterates that the amendments have not shifted the claims from the inventive group elected by Applicant.

Moreover, Applicant questions whether MPEP § 819 is applicable to the present circumstances. According to that provision, an applicant may not "shift to claiming another invention after an election is once made *and action given on the elected subject matter.*" (emphasis added) In the instant case, the PTO has not issued an office action on the merits of the claims. Thus, even if Applicant had shifted the claims from the Groups II and III, which to

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Applicant has not occurred in this case, it appears that Applicant's amendments have been proper under the section.

If the Examiner requires narrowing of the claims for purposes of examination, Applicant elects the species of mucosal mast cells. Claims 37-39, 42-53, and 56-80 read upon the elected species.

In view of the foregoing, Applicant requests withdrawal of the Notice of Non-Responsive Reply issued under 37 CFR § 1.111, withdrawal of the restriction between inventive Groups II and III, and that Claims 37-80 be examined on their merits. Claims 37-80 are consistent with the election made in Applicant's prior response, and examining claims directed to methods and compositions involving mucosal and connective tissue-type mast cells in a single application would place no undue burden on the Examiner.

The Commissioner is authorized to charge any necessary fees that may be required, including for extension of time, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. A-70882 (467802-00341)/AMP/CYO).

If the Examiner believes that there are further unresolved issues, Applicant encourages the Examiner to contact the undersigned attorney with any questions or concerns by telephone at (650) 494-8700.

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: October 14, 2003

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